

REMARKS

Claims 1-40 are currently pending. Applicants appreciate the Examiner's continued indication that patented claims 1-26 are allowed and the implicit indication that claims 27-40 are allowable over the prior art insofar as no prior art rejections are of record.

As an initial matter, applicants gratefully acknowledge the Examiner's pointing out that the Amendment of March 26, 2003 was not in the proper format. The changes to claims 29 and 34 are shown using the proper format, above. Additionally, applicants have complied with the Examiner's explicit instructions for adding the subject matter added to original claim 1 during the prosecution of the original application to claim 32 so as to avoid rejection under the "recapture rule". Hence, at least claims 32-36 are also allowable for reasons of record upon entry of this Amendment. Entry of this Amendment, insofar as it merely corrects technical defects in the presentation of the prior Amendment and complies with the Examiner's express instructions, is proper.

The Office Action includes a rejection of claims 27-40 under 35 U.S.C. §251, as allegedly being improperly broadened in a reissue application invoking the "recapture rule." With respect to claims 32-36, this rejection will be rendered moot by entry of the above change to claim 32. With respect to claims 27-31 and 37-40, applicants respectfully traverse the Examiner's rejection.

The Recapture Rule

As appropriately described in the recent case of *Ex parte Eggert*, (67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Int., 2003)), the recapture rule involves "complex legal and technical issues." *Id.* at 717. The reissue recapture rule summarized as follows in the *Eggert* opinion:

A patentee is precluded from recapturing in reissue that which he earlier conceded was unpatentable and abandoned or surrendered, whether by cancellation, amendment or argument of the claims, for the purpose of obtaining the original patent.

Id. at 1723.

Applicants respectfully submit that they are not attempting to recapture surrendered subject matter. The case law relied upon in the Office Action and the *Ex Parte Eggert* decision, involve a different fact pattern than presented by the present application. In the *Ex Parte Eggert* decision, the reissue applicants were claiming the same invention, i.e., a "bit holder", and the issue was whether or not the reissue claim was narrower in an aspect germane to a prior art rejection and broader in an aspect unrelated to that rejection.¹ In the *Eggert* decision the recapture rule did not bar a claim based on the predicate that the subject matter being claimed in the reissue application "was not subject to the administrative examination process as the Examiner was never directly presented with a claim which fell within the scope of the [new reissue claims]. Thus, appellants have never conceded that a

¹ It is noted that the Office offered a definition of a "broadening" reissue at page 3 of the Office Action. This definition is apparently distinct from "broadened" claims. *Id.* at 1724-1725.

claim falling within the scope of [the new reissue claims] is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule". *Id.* at 717.

The technical inquiry in the present application can be somewhat confusing because patented claim 1 refers to a light controlling means having a near, intermediate and far axial regions. New reissue claim 27 recites a lens having a near, intermediate and far axial regions. However, claim 27 is directed to a lens, whereas original claim 1 is directed to a lens device, i.e., a lens and a light controlling means. To illustrate the differences, the following nomenclature is offered.

| | |
|---|---|
| <p>Claim 1. Invention X comprising: A_{GENERIC}; and B_{SPECIFIC} including aspects B₁, B₂, B₃ and B₄</p> | <p>1. A lens device comprising: a lens focussing light into a focal zone and having a predetermined effective diameter; and light controlling means provided in a light path of said lens for preventing light in an intermediate axial region of said light path from reaching said focal zone, said intermediate axial region being located between near axial region which includes a center of said light path and a far axial region located radially outward from said intermediate region, said light controlling means permitting light in said near and far regions of said light path to reach said focal zone without imposing a relative phase change between light in said near and far regions.</p> |
| <p>Claim 27. Invention A comprising: C; D; and E</p> | <p>27. A lens for use with optical memory disks of at least two types, each type being distinguished from another by having information bearing levels at different locations along axes of said optical memory disks, comprising: a near axial region which includes a center of a light path; an intermediate axial region being located radially outward from said near axial region; and a far axial region located radially outward from said intermediate region, wherein said near region focuses light in said light path on the information bearing level regardless of which of said at least two types of optical memory disks.</p> |

| | |
|--|--|
| <p>Claim 30. Invention Z comprising: F; A', including C, D, and E; and G</p> | <p>30. An optical pick-up device for use with optical memory disks of at least two types, each type being distinguished from another by having information bearing levels at different locations along axes of said optical memory disks, comprising: a light source; an objective lens; a photodetector which detects light transmitted through said objective lens and focused on said photodetector after being reflected by a disk; wherein said lens includes a near axial region which includes a center of a light path; an intermediate axial region being located radially outward from said near axial region; and a far axial region located radially outward from said intermediate region, wherein said near region focuses light in said light path on the information bearing level regardless of which of said at least two types of optical memory disks.</p> |
| <p>Claim 37. Invention Z comprising: F; A; G; and B including aspects B₁, B₂, B₃, and B₅</p> | <p>37. An optical pick-up device for use with optical memory disks of at least two types, each type being distinguished from another by having information bearing levels at different locations along axes of the optical memory disks, comprising: a light source; an objective lens; a photodetector which detects light transmitted through said objective lens and focused said photodetector after being reflected by a disk; light controller provided in a light path of said lens which controls light in said light path before reaching said photodetector, said light controller includes a near axial region which includes a center of said light path, an intermediate axial region being located between near axial region and a far axial region located radially outward from said intermediate region, said light controller permitting light in said near region of said light path to focus on the information bearing level regardless of which of said at least two types of optical memory disks such that light in said near axial region reaches said photodetector.</p> |

As can be seen by the above table, independent claims 27, 30 and 37 do not claim the same invention as claim 1. Claim 1 is directed to a lens device including a lens and a light controlling means. In contrast, claim 27 is directed to a lens *per se*, and claims 30 and 37 to an optical pick-up. Hence, the case law relied upon by the Office and the *Ex parte Eggert* case do not apply to the current situation insofar as those cases are limited to situations where the reissue applicant was claiming the same invention.

More appropriate and on-point case law is represented by the *B.E. Meyers & Co. v. United States*, 56 U.S.P.Q.2d 1110 (Ct. Cl. 2000), which indicates that the recapture doctrine does not apply where in fact newly presented claims are drawn to a "separate invention eligible for patent protection, independent of whatever [element that was amended during the prosecution of the application] might be used in combination with [newly presented subject matter]." *Id.* at 1116. The *Meyers* decision is on point in many respects, including the general subject matter. In the *Meyers* decision, the original patent issued with claims directed to an infrared illuminator, which included a lens system and a pulsing circuit. The plaintiff later determined that the lens system *per se* was "in fact a separate invention that qualified for independent protection, regardless of whether the particular pulsing circuitry was used to control the power supply to the IR LED." *Id.* at 1112.

As with the *Meyers* patent, the present Examiner has found the subject matter of these claims to be an independent invention. Additionally, like the *Myers* decision, plaintiff can be viewed as surrendering the right to have patent protection for a generic light controlling means but claims 27 and 30 do not recite a light controlling means. Again, like the *Meyers* decision, these new independent claims dealt only with the lens and has nothing

to do with a light controlling means. Following the logic of the *Meyers* decision, the recapture rule does not apply. *Id.* at 1116.

This makes intuitive sense insofar as the applicants never claimed the lens with its specific features. Hence, this subject matter was never examined during the prosecution of the first application and could not have been surrendered. Instead, applicants during the prosecution of the original application simply claimed a generic lens and relied instead upon novel aspects of the light controlling means. In the present case of claims 27 and 30, the aspects of the lens are relied upon for patentability, which were not presented to the Examiner during the original application, and recitation of the light controlling means is wholly omitted.

Stated another way, the claims presented in the reissue application could have been subject to a restriction requirement relative to the patented claims. While the general subject matter of the present application was claimed, (e.g., a "lens" was claimed) in combination with a light controlling means and was not abandoned, the novel features of the lens *per se* were not.

In light of the foregoing, applicants respectfully submit that the *Myers* decision is controlling and directly on point. Therefore, at least claims 27 and 30 (along with dependent claims 28, 29 and 31) are allowable in light of this case law.

With respect to claim 37, a similar situation exists insofar as issued claim 1 is directed to a lens device including a lens and a light controlling means. Claim 37, in contrast to claim 1, is an optical pickup device for use with optical memory disks of at least two types. As an optical pickup device, it includes a light source, an objective lens, and a

photodetector, in addition to a light controller. Applicants did not previously present claims to an optical pickup device. It should be noted that the primary reference used in the original prosecution, i.e., *Okamoto* patent (U.S. Patent No. 5,502,001), is directed to a method of forming a light beam for use *in fabricating semiconductor integrated circuits*.

Had a claim such as claim 37 been presented to the Examiner in the original application, other arguments would have existed as to the patentability of the claims over the *Okamoto* patent. Further, claim 37 could have been subject to a restriction requirement if it were presented during the prosecution of the original application. This is a clear indication that the subject matter of claim 37 was not previously presented and therefore could not have been surrendered. Likewise, the *Matsui et al* patent (U.S. Patent No. 4,843,227) is directed to a focus directing apparatus for detecting the focus of a photo-taking lens.

In light of the foregoing, applicants respectfully submit that they have avoided the recapture issue and have demonstrated that the subject matter being claimed does not attempt to recapture subject matter that was surrendered during the prosecution of the original application to obtain the patent.

Request for Interview

Should the Office be unpersuaded by the above reasoning, the undersigned requests that an interview be conducted with the Special Programs Examiner present so that resolution of these matters can be quickly obtained.

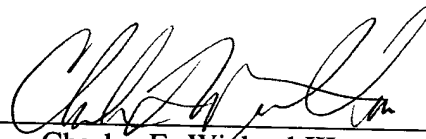
Conclusion

Applicants respectfully request withdrawal of the outstanding rejections and objections so that the present application may be reissued.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____



Charles F. Wieland III
Registration No. 33,096

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: October 10, 2003